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10/776,486	02/10/2004	Seiichi Katano	49987-1003	3258

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HICKMAN PALERMO TRUONG & BECKER, LLP  
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SAN JOSE, CA 95110

EXAMINER

MEDE, ESTEVE

ART UNIT	PAPER NUMBER
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2137

MAIL DATE	DELIVERY MODE
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07/06/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/776,486	<b>Applicant(s)</b> KATANO, SEIICHI	
	<b>Examiner</b> Esteve Mede	<b>Art Unit</b> 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/22/07</u> . | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. This office action is responsive to Applicant's amendment received on April 23, 2007. claims
2. Objections to Specification and claims have been withdrawn due to Applicants amendment.
3. Rejection under obviousness-type double patenting for claims 12, 16-26 has been withdrawn because of the terminal disclaimer filed on 04/23/2007.
4. Rejection under 35 U.S.C. 101 for claims 1-26 has been withdrawn due to Applicant's amendment.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boldon et al (US 2003/0048468 A1) in view of Phan (US 5,937,150).

**Regarding claim 1**, Boldon discloses a peripheral device for detecting a request for data to be analyzed for virus has been received over the network by a network device (para. 0019, lines 1-7); in response to detecting receipt of the request, causing data to be provided from the multi-function peripheral device to the network device over

the network to enable the data to be analyzed for viral infection at the network device (0016, lines 5-14; 0023, lines 1-9).

However Boldon does not disclose a multi-function peripheral device comprising a network interface configured to allow the multi-function peripheral device to communicate with network device over a network area; a graphical user interface configured to allow for the exchange of information between the multi-function peripheral device and one or more processors; a memory; a scan process executing in the memory and being configured to cause a printed document to be scanned at the multi-function peripheral device and to generate scan data that includes a digital data representation of the electronic document; a print process executing in the memory and being configured to process print data cause a printed version of an electronic document reflected in the printed data to be generated by the multi-function peripheral device at the multi-function peripheral device.

Phan discloses a multi-function peripheral device comprising a network interface (see abstract; Figure 2 item 215 and 220 of drawings; col. 3, line 6) configured to allow the multi-function peripheral device to communicate with network device over a network area (col. 1, lines 25-32; col. 2, lines 40-44); a graphical user interface configured to allow for the exchange of information between the multi-function peripheral device and a user (col. 5, lines 40-44; see fig. 4); one or more processors (col. 3, lines 10-12, lines 20-25; see fig. 2 of the drawings); a memory (see fig. 2; col. 3, lines 10-11, 14-17); a scan process executing in the memory and being configured to cause a printed document to be scanned at the multi-function peripheral device and to generate scan

data that includes a digital data representation of the electronic document. According to IEEE dictionary "a scanner is a graphic input device that automatically digitizes images for input to a computer". (The function of a scanner is implicitly stated by the prior art. See abstract); A print process executing in the memory and being configured to process print data cause a printed version of an electronic document reflected in the printed data to be generated by the multi-function peripheral device at the multi-function peripheral device (col. 3, lines 3-10; col. 4, lines 16-20).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Boldon to include the use a network interface, a graphical user interface, processor, memory, and a scanner in order to improve upon the functionality of the multi-function device of Boldon.

**Regarding claim 2-3**, Boldon discloses wherein providing data from the multi-function peripheral device to the network device over the network includes providing one or more data files to the network device over the network (paragraph 0016, lines 5-8); configuring data to the network device over the network (the prior art discloses information are sent to the device over a network that will change the functionality the way the device perform its job, although the prior art did not specifically uses the work "configuration", it is a fact that configuration is taking place base on instructions received (paragraph, 0016, lines 8-14).

**Regarding claim 7** Boldon discloses instruction when processed by one or more processors cause multi-function peripheral to perform the step of: receive a request from the network device for the multi-function peripheral to quarantine or delete at least

a portion of the data that was sent from the multi-function peripheral device to the network device (paragraph 0023, lines 1-5); and response to receiving the request from the network device to quarantine or delete at least a portion of the data that was sent to the network device, quarantine or delete the at least a portion of the data that was sent from the multi-function peripheral device to the network device (paragraph 0006, lines 4-7; paragraph 0007, lines 4-7; paragraph 0016, lines 5-14)

**Regarding claim 8**, Boldon discloses a virus protection process executing in memory and being configured to, upon receipt of data by the MFP device examine the data to determine whether the data contains one or more unauthorized instructions (para. 0023, lines 1-2); and in response to determining that the data contains one or more unauthorized instructions, perform one or more actions on the data to protect the multi-function peripheral device (0019, lines 6-9).

However Boldon does not disclose a multi-function peripheral device comprising a network interface configured to allow the multi-function peripheral device to communicate with network device over a network area; a graphical user interface configured to allow for the exchange of information between the multi-function peripheral device and one or more processors; a memory; a scan process executing in the memory and being configured to cause a printed document to be scanned at the multi-function peripheral device and to generate scan data that includes a digital data representation of the electronic document; a print process executing in the memory and being configured to process print data cause a printed version of an electronic

document reflected in the printed data to be generated by the multi-function peripheral device at the multi-function peripheral device.

Phan discloses a multi-function peripheral device comprising a network interface (see abstract; Figure 2 item 215 and 220 of drawings; col. 3, line 6) configured to allow the multi-function peripheral device to communicate with network device over a network area (col. 1, lines 25-32; col. 2, lines 40-44); a graphical user interface configured to allow for the exchange of information between the multi-function peripheral device and a user (col. 5, lines 40-44; see fig. 4); one or more processors (col. 3, lines 10-12, lines 20-25; see fig. 2 of the drawings); a memory (see fig. 2; col. 3, lines 10-11, 14-17); a scan process executing in the memory and being configured to cause a printed document to be scanned at the multi-function peripheral device and to generate scan data that includes a digital data representation of the electronic document. According to IEEE dictionary "a scanner is a graphic input device that automatically digitizes images for input to a computer". (The function of a scanner is implicitly stated by the prior art. See abstract); A print process executing in the memory and being configured to process print data cause a printed version of an electronic document reflected in the printed data to be generated by the multi-function peripheral device at the multi-function peripheral device (col. 3, lines 3-10; col. 4, lines 16-20).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Boldon to include the use a network interface, a graphical user interface, processor, memory, and a scanner in order to improve upon the functionality of the multi-function device of Boldon.

**Regarding claims 10-11**, Boldon discloses a virus protection process configured to, upon receipt of data by the multi-function peripheral, examine the data to determine whether the data contains one or more unauthorized instructions perform one or more actions (it is factual and accurate that viruses must be executable program codes in order for the virus to work (paragraph 0022, lines 3-10; paragraph 0019, lines 3-9)).

**Regarding claim 12**, Boldon discloses a virus protection process executing in the memory and being configured which would be able to provide virus check on data prior sending to the network (para. 0015-0017); in response to determining that the data contains a virus perform one or more action (para. 0007, lines 4-7).

However Boldon does not disclose a multi-function peripheral device comprising a network interface configured to allow the multi-function peripheral device to communicate with network device over a network area; a graphical user interface configured to allow for the exchange of information between the multi-function peripheral device and one or more processors; a memory; a scan process executing in the memory and being configured to cause a printed document to be scanned at the multi-function peripheral device and to generate scan data that includes a digital data representation of the electronic document; a print process executing in the memory and being configured to process print data cause a printed version of an electronic document reflected in the printed data to be generated by the multi-function peripheral device at the multi-function peripheral device.

Phan discloses a multi-function peripheral device comprising a network interface (see abstract; Figure 2 item 215 and 220 of drawings; col. 3, line 6) configured to allow



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the multi-function peripheral device to communicate with network device over a network area (col. 1, lines 25-32; col. 2, lines 40-44); a graphical user interface configured to allow for the exchange of information between the multi-function peripheral device and a user (col. 5, lines 40-44; see fig. 4); one or more processors (col. 3, lines 10-12, lines 20-25; see fig. 2 of the drawings); a memory (see fig. 2; col. 3, lines 10-11, 14-17); a scan process executing in the memory and being configured to cause a printed document to be scanned at the multi-function peripheral device and to generate scan data that includes a digital data representation of the electronic document. According to IEEE dictionary "a scanner is a graphic input device that automatically digitizes images for input to a computer". (The function of a scanner is implicitly stated by the prior art. See abstract); A print process executing in the memory and being configured to process print data cause a printed version of an electronic document reflected in the printed data to be generated by the multi-function peripheral device at the multi-function peripheral device (col. 3, lines 3-10; col. 4, lines 16-20).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Boldon to include the use a network interface, a graphical user interface, processor, memory, and a scanner in order to improve upon the functionality of the multi-function device of Boldon.

**Regarding claim 13** Boldon discloses one or more actions include not sending the data to the network device (it is factual in order for a information to be transmitted to a network, the information must be first exist; the prior art discloses that upon detection

of a virus one of the actions that may taking place is deleting the information that contain the virus base on the filter, therefore infected file would not be sent to the network (paragraph 003, lines 11-14; paragraph 0007, lines 4-7)).

**Regarding claim 14** Boldon discloses the one or more actions include generating and providing a notification that indicates that the multi-function peripheral has the data that has been infected by a virus (paragraph 0007, lines 4-7).

**Regarding claim 15**, Boldon discloses a virus protection process configured to, upon receipt of data by the multi-function peripheral, examine the data to determine whether the data contains one or more unauthorized instructions perform one or more actions (it is factual and accurate that viruses must be executable program codes in order for the virus to work (paragraph 0022, lines 3-10; paragraph 0019, lines 3-9)).

**Regarding claim 16**, Boldon discloses the virus protection process is configured to detect that one or more unauthorized instructions have been stored on the multi-function peripheral by examining and detecting that the data has been modified (paragraph 0006, lines 4-7).

**Regarding claim 17**, Phan discloses a multi-function device wherein the data is stored on a non-volatile memory (col. 3, lines 10-15).

**Regarding claim 18**, Boldon discloses all the limitation of claim 18 except that the data is stored in volatile memory. The general concept of storing data in volatile memory is well known in the art as illustrated by Walsh, which discloses the system memory includes a random access memory (RAM), which is a volatile type of memory (column 8, lines 11-13). Therefore it would have been obvious for one of ordinary skill in

the art at the time of the invention to include the use of volatile memory in order to access data that need to be processed.

**Regarding claim 19** Boldon discloses the virus protection process is further configured to undo changes made as a result of execution of the one or more unauthorized instructions (paragraph 00016, lines 8-12).

**Regarding claim 21** Boldon discloses the virus protection process is further configured to render the data inaccessible on the multi-function peripheral (the prior did not use the phrase inaccessible, however the prior disclose upon detection of a virus that the data will be deleted, therefore deleting the data will render the it inaccessible (paragraph 0019, lines 5-8).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boldon et al. (US 2003/0048468 A1) in view of Phan (US 5,937,150) further in view of Kouznetsov (US 2004/0025042 A1).

**Regarding claims 4-6** Boldon and Phan discloses all the limitation of claims 4-6, except for replacing data replacement after deleting action had taken place, generating a report a component manager and send a conformation message out to the device

(client). Kouznetsov discloses receiving replacement data for the multi-function peripheral (paragraph 0161, lines 1-2; paragraph 016, lines 1-2); generate and send a conformation message to the network device (paragraph 0341, lines 5-7; lines 11-13); and generate a report and either print the report or fax the report (paragraph 0377, lines 1-5; see table 68c; paragraph 0078, lines 6-7). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Boldon to include the use of data replacement, report generation and conformation in order for the virus scanner to perform certain task such as generating a report to system administration or user confirming that the replacement data is free of infection base on define criteria set forth by the administrator at the time of configuration.

11. **Claim 9, 20, and 22-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Boldon et al. (US 2003/0048468 A1) in view of Phan (US 5,937,150) further in view of Walsh et al. (US 5,956,481).

**Regarding claim 9** Boldon discloses all the limitation of claim 9 except that the wherein the virus protection process is further configured to prevent the data from being stored on the multi-function peripheral. Walsh discloses preventing a virus from loading and infect other systems (column 11, lines 59-67). Therefore it would been obvious to one of ordinary skill in the art at the time of the invention to modify Boldon to include the use of preventing the infected data access to storage in order to prevent the virus from spreading to other area in the system as recited in column 11, lines 64-66.

**Regarding claim 20** Boldon and Phan discloses all the limitation of claim 20 except that determining whether the data stored on the multi-function peripheral can be

restored to a prior state. Walsh discloses removing the virus from the infected date (file). Therefore it would have been obvious for one of ordinary skill in the art at the time of the invention to modify Boldon to include to the use of re-storing a file after the virus has been removed from it in order to recover the original data, such that the recovered data may be used in future transactions.

**Regarding claim 22-26** Boldon and Phan discloses all the limitation of claim 22-25 except for the method of contacting the user is being made by graphical user interface, printer, email or facsimile. Walsh discloses that a notification is sent to the user by a user interface displayed on a computer monitor (column 3, lines 21-22; column 10, lines 12-16). Therefore it would have been obvious for one of ordinary skilled in the art at the time of the invention to modify Boldon to include the use of a display monitor, printer, email and facsimile in order to report to system administrator that data on the multi-function device contains unauthorized instructions.

### ***Response to Arguments***

10. Applicant's arguments filed 04/23/2007 have been fully considered but they are not persuasive.

Applicant argument regarding Boldon does not teach, "A printing device ever requests that an originator of a print job send the print job to the printing device so that the print job can be analyzed for viral infection" in claim 1.

The examiner disagrees. Boldon discloses a multi-function printer, which configured to be able to receive and send data over a network and scan data for viral

infection (see para. 0016, lines 5-14; para. 0019). Applicant added more features (a network interface, a graphical user interface, one or more processors, a memory, a scan process and a print process) to the claim after the amendment.

Applicant argument regarding Boldon multi-function device is not the same as that of the applicant of claim 8, is well taught by the combined teaching of Boldon et al. (US 2003/0048468 A1) and Phan (US 5,937,150). Applicant added more features (a network interface, a graphical user interface, one or more processors, a memory, a scan process and a print process) to the claim after the amendment.

Applicant argument regarding 12 does not teach "prior to sending data from the multi-function device to a network device over a network, examine the data to determine whether the data contains one or more unauthorized instructions; and in response to determining that the data contains one or more unauthorized instruction, perform one or more actions" in claim 12. Applicant added more features (a network interface, a graphical user interface, one or more processors, a memory, a scan process and a print process) to the claim after the amendment.

The examiner disagrees. Boldon disclose a multi-function device that is configured to scan for viral infection send and received data (see para. 0015-0017).

***Conclusion***

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Esteve Mede whose telephone number is 571-270-1594. The examiner can normally be reached on Monday thru Friday, 8:30-5:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Esteve Mede

em  
06/25/2007

  
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SUPERVISORY PATENT EXAMINER